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Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Jeffrey H. ALGER ET AL.

Application No.: 09/859,565

Filed: May 16, 2001

For: Merchant Branded Software

Examiner: N. Vig

Art Group: 3629

Attorney Docket No.: 003797.00014

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office at (503) 273-8300 on the date specified below:

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION
OF THE OFFICE ACTION DATED MARCH 24, 2006**

Sir:

Applicant's respectfully ask for reconsideration of both this application and the Office Action dated March 24, 2006.

In the Office Action, the Examiner initially maintained the Restriction Requirement set forth on November 22, 2005. The Examiner further stated that, if Applicants maintained the traversal of this Office Action, Applicants

...must amend the limitation in the pending claims of "browser" to "browser application" to claim the single invention as claimed in claim 1 in the application. (See Office Action, page 2, lines 11-13.)

First, Applicants respectfully point out that there appears to be no basis in either the patent rules or the MPEP that would support the Examiner's "requirement" to amend the claims in order to traverse a restriction requirement. Second, Applicants note that the Examiner did not

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indicate that the Restriction Requirement would be withdrawn, even if Applicants were to make the amendment required by the Examiner. Third, the Examiner later indicated that he as treated the terms "browser" and "browser application" as equivalent limitations. (See Office Action, page 5, lines 7-9.) Accordingly, Applicants are unclear as to the reasoning behind the Examiner's requirement to amend the claims.

Applicants again respectfully point out that the outstanding Restriction Requirement is clearly improper in any case, and should be withdrawn. As previously noted, the MPEP expressly directs the Examiner to search all of the claims in this application unless it presents a *serious burden*. (See MPEP §803, *emphasis added*). As also previously, noted, the Examiner already has examined all of the restricted claims. Applicants therefore cannot understand how the Examiner can now argue that examining all of these claims presents an undue burden.

Applicants again respectfully point out that they should not be penalized for attempting to further the prosecution of this application by amending previously dependent claims into independent form, as the Examiner would do by the outstanding Restriction Requirement. Further, Applicants have paid the examination fees associated with all of the claims in this application, and were therefore entitled to a proper examination of these claims in accordance with MPEP §904. If the Examiner performed such an examination before issuing the first Office Action, then the instant Restriction Requirement should be unnecessary. Accordingly, Applicants respectfully submit that the outstanding restriction requirement is improper, and ask that it be withdrawn.

Next, the Examiner rejected claims 35 U.S.C. §112, second paragraph. The Examiner did not actually state a grounds of rejection, however. Instead, the Examiner noted only that some claims recite the term "browser application." Because the Examiner has not stated any actual

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grounds of rejection to support this rejection, Applicants therefore cannot respond to this rejection, other than to ask that it be withdrawn.

The Examiner rejected claims 1, 2, 5-12, 14-17, 19-22, 26, 30, 31, 33, 34, 36, 37, and 39 under 35 U.S.C. §102(b) over Web pages ostensibly¹ made available on the Internet by 1stUp.com over dates between November 2, 1999, and February 13, 2001, hereafter referred to as the "1stUp.com pages." Similarly, claims 3, 24, 25, 28, 29, 32, 35, 38, 40-42 and 44-46 were rejected under 35 U.S.C. §103 over the 1stUp.com pages. Applicants courteously traverse these rejections, and again ask for their reconsideration.

Claims 1-3, 5-12, 14-17, 19-22, 24 and 25 recite that the core portion of the electronic data includes a browser that retrieves and renders content. Applicants again submit that this feature of the invention is not taught or suggested by the 1stUp.com pages. Instead, the 1stUp.com pages appear to disclose a small application that is downloaded and used in conjunction with a conventional browser (i.e., a browser that does not evoke an association with a merchant). More particularly, the 1stUp.com pages generally disclose a business method whereby a sponsor provides free Internet access to a customer, in return for the customer continuously maintaining an "always-on" navigation bar with links to the sponsor's Web sites. (See, e.g., pages 6 and 9 of the 1stUp.com pages.) Applicants respectfully point out, however, that the 1stUp.com pages further disclose that the navigation bar is obtained by "the easy download of a small, 700k application." (*Id.*, page 11.) Thus, the 1stUp.com pages teach

¹ Applicant points out that the 1stUp.com pages were not contemporaneously printed, but instead appears to be recently obtained from a Web site or search engine identified only as "Internet Archive - Way Back Machine." Applicants do not concede the historical accuracy of this Web site or search engine. Moreover, nothing in the 1stUp.com pages or the "Internet Archive - Way Back Machine" pages indicate that the 1stUp.com pages were actually publicly available more than one year prior to Applicants' filing date. The Examiner has referred Applicants to dates on the Web pages. Applicants point out, however, that, since these Web pages can no longer be viewed, Applicants cannot be certain that these printed dates were not recently added to the Web pages by the "Internet

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providing the navigation bar to the user separately from the browser software. Moreover, because the 1stUp.com pages teach an application specifically designed to be used with a conventional browser, Applicants submit that the 1stUp.com pages would actually teach away from the invention as recited in claims 1-3, 5-12, 14-17, 19-22, 24 and 25.

With regard to claims 26-29, Applicants respectfully submit that the rejections of claims 27 and 29 are moot, as these claims are canceled herein. Applicants respectfully traverse the rejections of pending claims 26 and 28, and ask for their reconsideration. Claim 26 is amended herein to recite that the second data field contains functionality branding that provides the core data with at least one function that evokes an association with a merchant. This feature is not taught or suggested by the 1stUp.com pages. Instead, these pages disclose only a conventional function of having the associated browser access a Web site specified by a sponsor or partner.

Regarding claims 30-42, Applicants respectfully traverse the rejections of these claims, and courteously ask for their reconsideration. Each of claims 30, 33, 36, and 39 recite that the software application includes a browser for retrieving and rendering content. As discussed in detail above, this feature is not taught or suggested by the 1stUp.com pages. Applicants therefore urge that the rejections of claims 30-42 be withdrawn.

It is believed that no fees are required for the consideration and entry of this Response. If, however, the Commissioner believes fees are required, he is authorized to charge such fees to Deposit Account No. 19-0733.

In view of the above remarks, Applicants respectfully submit that all of the claims are allowable, and that this application is therefore in condition for allowance. Favorable action in

Archive - Way Back Machine" and thus might be inaccurate. Applicants therefore again reserve the right to challenge the applicability of the 1stUp.com pages as prior art to the instant application.

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this regard is courteously requested at the Examiner's earliest convenience.

Respectfully submitted,

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